UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,955	10/24/2001	Trevor Harms	051373-0115	8428

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/039,955	HARMS ET AL.
	Examiner	Art Unit	
	Aaron Strange	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,16-20,22,23 and 26-28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,16-20,22,23 and 26-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

1.   The Examiner would like to note that the present Application has been

reassigned to a new Examiner.

Response to Arguments

2.   Applicant's arguments filed 6/11/07, with respect to the rejection of claim 5 have

been fully considered but they are not persuasive.

3.   With regard to claim 5, and Applicant's assertion that the specification describes

the subject matter of claim 5 (Remarks, 6-7), the Examiner respectfully disagrees. As

noted in the Office action of 3/9/07 the only portion of the specification even mentioning

time stamps is ¶38, which states "Scanning messages since a certain time stamp, such

as the last scan time, or only scan new messages. The time stamp can be automatically

updated on each scan."

This language fails to provide support for scanning messages based on time

stamps "associated with each message", as claimed in claim 5. Applicant explains that

a time stamp "associated with" a message is attached to the message at the time the

message is sent or received (Remarks, 7). It is clear that these time stamps are static

and *cannot* "be automatically updated on each scan", as described by the specification.

The language of the specification makes it clear that the described time stamp is

a time stamp set at the time a scan is performed, and describes performing a scan of

messages since that time. Only a single time stamp is described, not a plurality of time stamps "associated with each message".

Furthermore, even if the described timestamp was "associated with each message", there is simply no disclosure of scanning before a preselected timestamp or during a preselected time period between two timestamps. Therefore, the rejection of claim 5, presented under 35 U.S.C. § 112, first paragraph, is maintained.

4.   The remaining rejections under 35 U.S.C. § 112, first paragraph, have been withdrawn. Claims 12-15, 21, and 23 have been cancelled, obviating the rejection and the rejection of claims 4, 22 and 24 has been withdrawn upon further consideration.

5.   Applicant's arguments filed 6/11/07 with respect to the rejection of claims 1-11 and 16-20 have been fully considered but they are not persuasive.

6.   With regard to claim 1, and Applicant's assertion that Tafoya "resolution list" is not a "contact list" (Remarks, 8-9), the Examiner respectfully disagrees. As an initial matter, it is noted that Applicant has not defined "contact list" in the claims or the specification. Applicant has, in the amendment filed 6/11/07, limited the claimed contact list to one that is configured to receive information directly entered into the contact list bya person via a text entry device, but Tafoya's resolution list also permits this (contact information is entered into the list when the user addresses an email using the portable device) (col. 9, II. 59-63).

7.   With regard to claim 16, and Applicant's assertion that Tafoya fails to disclose

"entering of contact information into a contact list, wherein only a portion of a contact

entry for an individual entry is modified with the extracted information or is replaced with

the extracted information" (Remarks, 10-11), the Examiner respectfully disagrees.

Tafoya clearly discloses modifying only a portion of an individual entry when entering

contact information into a contact list (entries are updated as new information becomes

available)(col. 10, ll. 12-27).

8.   New claims 26-28 have been addressed below.

Claim Objections

9.   Claims 22 and 26 are objected to because of the following informalities:

a.   Claim 22 contains a typographical error "for a contact" [no period] in lines

2-3.

b.   Claim 26 contains a typographical error "stored or there information" in

lines 1-2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

10.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11.   Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12.   With regard to claim 5, the specification fails to provide support for time stamps "associated with each message" or scanning before a preselected timestamp or during a preselected time period between two timestamps.

As discussed above, the only relevant portion of the specification is ¶38, which fails to provide support for scanning messages based on time stamps "associated with each message", as claimed in claim 5. Applicant explains that a time stamp "associated with" a message is attached to the message at the time the message is sent or received (Remarks, 7). It is clear that these time stamps are static and *cannot* "be automatically updated on each scan", as described by the specification.

The language of the specification makes it clear that the described time stamp is a time stamp set at the time a scan is performed, and describes performing a scan of messages since that time. Only a single time stamp is described, not a plurality of time stamps "associated with each message".

13.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14.   Claims 16-20, 24 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15.   With regard to claim 16, the limitation "a storage device ... having stored there information for configuring the CPU to" renders the claim indefinite. Since the information that may be used "for configuring the CPU" to perform the claimed functions is virtually limitless, the scope of the claim in unascertainable.

The Examiner recommends the claim be amended to include a positive recitation such as "a storage device coupled to the CPU, having stored thereon computer executable code, which when executed by the CPU, causes the CPU to:" or a similar recitation which clearly defines the content of the storage device.

16.   With regard to claim 17, the limitation "wherein the CPU is further configured to" is unclear because the CPU was not configured in claim 16, from which claims 17 depends. Claim 16 merely contained a limitation directed to "information for configuring the CPU", but did not actually configure the CPU to do anything. Claims 18-20 contain a similar recitation, and are rejected under the same rationale.

17.   All claims not individually rejected are rejected by virtue of their dependency from

the above claims.

Claim Rejections - 35 USC § 102

18.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

19.   Claims 1-11, 16-20 and 26-28 are rejected under 35 U.S.C. 102(e) as being

anticipated by Tafoya et al. (US 6,829,607).

20.   With regard to claim 1, Tafoya disclosed a method for populating a contact list

(e.g. address book or resolution list) on a portable device (e.g. hand-held device, Col 5,

lines 24-28), the method comprising:

        extracting contact information from a number of messages stored in a memory in

the portable device (e.g. initially populating the resolution list, see inter alia Col 7, lines

9-54); and

automatically entering the extracted contact information upon extraction into a

contact list (e.g. resolution list) that is configured to receive information directly entered

into the contact list by a person via a text entry device (contact information is entered

into the list when the user addresses an email using the portable device) (col. 9, ll. 59-

63) and that is maintained by a program operating on the portable device (see inter alia

Col 7, lines 9-54) (for operating on the portable device see Col 5, lines 23-33).

21.   With regard to claim 2, Tafoya disclosed extracting contact information includes

monitoring incoming messages and retrieving contact info information from incoming

messages (dynamically update the resolution list, Col 9, lines 59-63).

22.   With regard to claim 3, Tafoya disclosed contact information includes an SMTP

email address (Col 7, line 51).

23.   With regard to claim 4, Tafoya disclosed extracting contact information includes

scanning a message database and retrieving contact information from messages

contained in the database (e.g. initially populating the resolution list, see inter alia Col 7,

lines 9-54).

24.   With regard to claim 5, Tafoya disclosed only message sent or received after a

pre-selected time stamp are scanned (e.g. after the program is started only new entries

are dynamically scanned, Col 9, lines 51-63).

25.   With regard to claim 6, Tafoya disclosed only messages sent or received after a time of a last scan are scanned (e.g. after the program is started only new entries are dynamically scanned, Col 9, lines 51-63).

26.   With regard to claim 7, Tafoya disclosed entering the extracted contact information into a contact list maintained by a program operating on the portable device includes providing a GUI with contact information configured to receive a selection from a user of the portable device (see inter alia, Col 11, lines 42-54).

27.   With regard to claim 8, Tafoya disclosed automatically entering in the contact list only contact information not already contained in the contact list (Col 10, lines 13-17).

28.   With regard to claims 9 and 10, Tafoya disclosed filtering contact information to include or exclude from the contact list contact information from emails and retrieved addresses received from certain domains (Col 11, lines 9-22).

29.   With regard to claim 11, Tafoya disclosed filtering contact information to include in the contact list only email sender information (Col 8, lines 10-26).

30.   With regard to claim 16, Tafoya discloses a system comprising:

a CPU and storage device coupled to the CPU (portable device)(col. 5, ll.

24-28), configured to:.

extract information from a number of messages stored in memory in the

portable device (e.g. initially populating the resolution list, see inter alia Col 7,

lines 9-54); and

enter contact information into a contact list (e.g. resolution list) maintained

by a program operating on the portable device (see inter alia Col 7, lines 9-54)

(for operating on the portable device see Col 5, lines 23-33), wherein only a

portion of a contact entry for an individual entry is modified with the extracted

information or is replaced with the extracted information (see inter alia, Col 10,

lines 12-27).

31.   With regard to claim 17, Tafoya further discloses that the CPU is configured to

monitor incoming messages and retrieve contact information from incoming messages

(dynamically update the resolution list, Col 9, lines 59-63).

32.   With regard to claim 18, Tafoya further discloses that the CPU is configured to

scan a message database and retrieve contact information from messages contained in

the database (e.g. initially populating the resolution list, see inter alia Col 7, lines 9-54).

33.   With regard to claim 19, Tafoya further discloses that the CPU is configured to provide a GUI with contact information configured to receive a selection from a user of the portable device (see inter alia, Col 11, lines 42-54).

34.   With regard to claim 20 Tafoya further discloses that the CPU is configured to automatically enter into the contact list only contact information not already contained in the contact list (Col 10, lines 13-17).

35.   With regard to claim 26, Tafoya further discloses that the storage device has stored thereon information for configuring the CPU to automatically enter the contact information into the contact list upon extracting the information from the number of messages (col. 9, ll. 10-21).

36.   With regard to claim 27, Tafoya further discloses that only a portion of a contact entry for an individual entity is modified or replaced with the entered extracted contact information (properties are updated as new information becomes available)(col. 10, ll. 13-27).

37.   Claims 28 is rejected under the same rationale as claims 1 and 16, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Claim Rejections - 35 USC § 103

38.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

39.   Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Tafoya et al. (US 6,829,607) in view of Spencer et al. (US 6,349,299).

40.   With regard to claims 22 and 24, while the system disclosed by Tafoya shows

substantial features of the claimed invention (discussed above), it fails to specifically

disclose that the contact information includes phone information.

Spencer discloses a similar system for automatically extracting and storing

contact information in a database. Spencer teaches extracting and storing telephone

information (col. 9, ll. 41-50). This would have been an advantageous addition to the

system disclosed by Tafoya since it would have allowed telephone information to be

automatically extracted and stored in the contact list, providing the user with additional

information about their contacts.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to extract and store telephone information about contacts

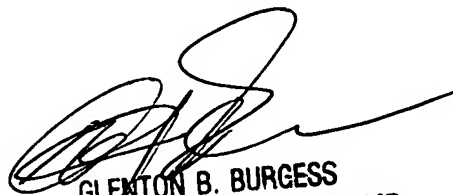in addition to other contact information.

Conclusion

41.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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